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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/378,222 08/19/99 PHILYAW

J PHL-24.670

EXAMINER

TM02/0508

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ART UNIT

PAPER NUMBER

2152

DATE MAILED:

05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/378,222

Applicant(s)  
Philyaw et al.

Examiner  
Almari Romero

Art Unit  
2152



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 26, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Mar 26, 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 6 20) ☐ Other:

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## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because improper format regarding reference numbers in parenthesis.

Correction is required. See MPEP § 608.01(b).

### ***Information Disclosure Statement***

2. The reference JP 10122140A filed on 12/24/96 was not not considered because a translation of English language was not provided.

### ***Claim Rejections - 35 U.S.C. § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry et al. (U.S. Patent No. 6,195,693) in view of Roberts et al. (U.S. Patent No. 6,161,132).

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5. Regarding claim 3, Berry et al. (Berry) discloses the invention substantially as claimed. Berry discloses; a method for effecting a connection between a user node on a network and a destination node on the network with an audio program (on col. 6, lines 38-48 and col. 8, lines 47-64, see fig. 5: teaches audio CD (audio program) and communication between client 92 (user node) and destination node 88) , comprising steps of : playing at the user node the audio program having embedded therein a unique code (col. 10, lines 16-42: teaches audio CD (audio program) containing an encoded unique identifier (unique code) and audio CD is loaded onto a CD player (playing audio program)); detecting the unique code at the user node during the playing of the audio program at the user node (col. 10, lines 16-26: teaches information queried (detecting) from audio CD (audio program) to identify CDS unique identifier (unique code)); transmitting information regarding the unique code over the network to an intermediate node on the network (col. 8, lines 47-64 and col. 10, lines 16-42, see fig. 5: teaches unique identifier (unique code) is compared to a registry of codes on a remote server (intermediate node)); matching received information regarding the unique code; defines the location on the network of a plurality of destination nodes, the database having stored therein a correspondence between unique codes and select ones of the destination nodes (col. 10, lines 29-42: teaches comparing unique identifier (unique code) to a registry of codes (database) on a remote server which provides a directory to a server location (location of destination nodes)); and if there is a match between received unique code and a unique code stored in the database (col. 10, lines 29-42: teaches matched codes identified), causing the destination node and the user node to be connected over the network (col.

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8, lines 47-64, see fig. 5: teaches servers 88 (destination node) and clients 92 (user node) connected over the network 80). However, Berry does not explicitly disclose “routing information stored in a database at the intermediate node”. Roberts et al. (Roberts) on col. 6, lines 33-40: teaches a Web address (URL) (routing information) stored in a database at a server that is related to the audio CD unique identifier. It would have been obvious to one of an ordinary skill in the art at the time the invention was made to incorporate a Web address (URL) (routing information) stored in a database at a server, as taught by Roberts, to identify server 88 (destination node) to connect with client 92 (user node), as taught by Berry, in over the network. The motivation to do so would have been to provide a Web address (URL) (routing information) stored in a database at a server to identify the server (destination node) that will connect to the client (user node) over the network in order to increase the flexibility to provide on-line services.

6. Regarding claims 4-6, Berry on col. 11, lines 5-38: teaches a code corresponding to the unique identifier (unique code) is identified and data (which can be music as an audible code and unique tone) corresponding to the unique identifier is retrieved.

7. Regarding claim 7, Berry on col. 8, lines 47-64, see fig. 5: teaches global communication network.

8. Regarding claim 8, Roberts on col. 6, lines 33-40: teaches a displaying to client (user node) a Web address (URL) (routing information) stored in a database at a server that is related to the audio CD unique identifier and Berry on col. 8, lines 47-64, see fig. 5: teaches client 92

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(user node) connected to a server 88 (destination node) via providers 84 and 86 (intermediate nodes) over the network (80).

9. Regarding claim 9, Berry on col. 8, lines 47-64, see fig. 5: teaches Internet Service Providers 84 and 86 as intermediate nodes between client (92) (user node) and server (88) (destination node), it is known in the art that Internet Service Providers can have stored profiles associated with the client (92) to identify client and provide access to servers (88) (connect client with server) and on col. 10, lines 16-42, see fig. 7: teaches identifying unique identifier (unique code) encoded in audio CD, comparing unique identifier (unique code) to registry of codes at a remote server (intermediate node) providing server location, if there is a match, go to referenced site (destination node). Roberts on col. 6, lines 33-40: teaches a Web address (URL) (routing information) stored in a database at a server that is related to the audio CD unique identifier which is transmitted to the client (user node).

10. Regarding claims 1-2 and 10-18, are substantially the same as claims 3-9 and are thus rejected for reasons similar to those in rejecting claims 3-9.


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***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Romero whose telephone number is (703) 305-0749. The examiner can normally be reached on Mondays-Fridays from 7:30 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for this Group is (703) 305-9731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
Almari Romero  
Patent Examiner  
Art Unit 2152

  
MARK H. RINEHART  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100